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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,825	11/30/2001	Michael B. Sundel	002250-2	2660
22204	7590	05/02/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/996,825	SUNDEL, MICHAEL B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Narayanswamy Subramanian	3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 23-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 23-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This office action is in response to applicants' request for continued examination filed on January 31, 2006. Amendments to claims 1, 31-33 and 52 have been entered. Claims 1-11 and 23-52 are pending in the application and have been examined. Affidavit filed by the applicant under 37 CFR 1.132 on November 4, 2005 has been entered. Rejections made under 35 USC 112, second paragraph and claim objections made in the final office action mailed on May 4, 2005 are withdrawn in view of the amendments. The rejections and response to arguments are stated below.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 33-52 are rejected because the claimed invention is directed to non-statutory subject matter.

Claims 33-52 of the disclosed invention is inoperative and therefore lacks utility.

Claims 33-52 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure

was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 32 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32 and 52 recite the limitation “wherein the system comprises one or more hardware and/or software devices”. However it is not clear how these devices are related to the means identified in the respective claims they are dependent on. The functional and structural relationship between the hardware devices and the means are not specified in the claim. Hence the metes and bounds of these claims are unclear. Appropriate clarification/correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-11 and 23-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al (US Pub. No. 2002/0032612 A1).

Claims 1 and 33, Williams teaches a computer-implemented method and system for processing shipment and return of a package containing items from a Sender to a Recipient (See Williams Abstract), the method comprising the steps of: electronically storing package data, for the package, and including item data, for the items in the package, in a database (See Williams Paragraphs 148-150, 375, Figures 27A and 40); electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism (See Williams Paragraphs 148-152, 375); electronically adding the shipment tracking data to the database (See Williams Paragraphs 148-152); electronically correlating the package data in the database with the shipment tracking data (See Williams Paragraphs 149, 455-472); and permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-410).

Claims 2 and 34, Williams teaches the step of electronically assigning the package to a specific combination of a shipper and shipping method based on the package data (See Williams Figures 12 and 38, Paragraphs 330-371).

Claims 4-11 and 36-43, Williams teaches the steps wherein the package data includes at least the originating address and the destination address (See Williams Figure 27A), and the item data includes a description of the items in the package (See Williams Paragraph 150), said

method further comprising the step of: using the package data to electronically calculate shipping charges and electronically generate invoices associated with the shipment (See Williams Paragraph 333); wherein the item data includes the description and value of each item (See Williams Paragraph 150); wherein the step of storing package data comprises transmitting package data via the Internet (See Williams Paragraphs 138, 139 and 142); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network including the Internet in response to the query parameters (See Williams Paragraphs 138, 139 and 142); further comprising the steps of: electronically adding returned item information to the database if items from the package are returned to the Sender (See Williams Paragraph 150); in the case of international shipments, electronically preparing duty and tax refund claims based on the returned item information and the corresponding item data; and electronically adding duty and tax refund information to the database (See Williams Paragraphs 187, 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters (See Williams Paragraphs 152 and 153); wherein the computer network comprises the Internet (See Williams Paragraphs 142, 152 and 153).

Claims 23-26, 28-30, 44-47 and 49-52, Williams teaches the steps and means of selecting a shipping assignment for the package based on the package data (See Williams Paragraphs 330-371); generating appropriate shipping documents for the package (See Williams Abstract and Paragraph 17) comprising package labels (See Williams Paragraph 258) and shipping manifests (See Williams Paragraphs 396 and 404); providing a Web site page for permitting the authorized

user to query the database (See Williams Paragraphs 173, 174, 179-182); generating duty and tax refund claims based upon Receipt of returned item data (See Williams Paragraphs 497 and 533); adding return item information to said database if items from a package are returned to the Sender (See Williams Paragraph 639), and preparing duty and tax refund claims based on the returned item information (See Williams Paragraphs 497 and 533).

Claims 31, 32 and 52, Williams teaches computer program product including one or more computer-readable instructions configured to cause one or more computer processors to perform the steps recited in claim 1 and a computer system including one or more hardware and/or software devices configured to perform the steps recited in method of claim 1 (See discussion of claims 1 and 33 above). A computer program product and a computer system including one or more hardware and/or software devices are inherent in the disclosure of Williams.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 27, 35 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US Patent 2002/0032612 A1) in view of Riggs et al (US Patent 2002/0065738 A1).

Claims 3, 27, 35 and 48 Williams teaches a method and system of claims 1 and 33 respectively as discussed above.

Williams does not explicitly teach the steps of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker and generating appropriate customs forms.

Riggs teaches the steps of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker (See Riggs Paragraphs 88-91) and generating appropriate manifests and customs forms (See Riggs Paragraphs 55 and 88).

Both Williams and Riggs are concerned with providing transport logistics support for users in shipping goods. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of complying with customs regulations in one session using a user-friendly interface.

#### ***Response to Arguments***

10. In response to applicant's argument that the references fail to show the features of "correlating package data, for the package, and including item data, for the items in the package, with shipment tracking data for the package", the examiner respectfully disagrees. In paragraphs 149 and 455-472, Williams et al teaches this feature. For instance in paragraph 455, Williams discloses that product information is repeated for every product in the package. Hence the products in the package are distinguished from the package itself thereby enabling tracking of each product.



In response to applicant's argument that the references fail to show certain features or advantages of applicant's invention, it is noted that the features and advantages upon which applicant relies (i.e., "Advantageously, "returns can be handled on an item-by-item basis, rather than on a shipment-by-shipment basis," "items are correlated to an accurate description thereof to facilitate customs clearance of each item," and "each package, and each item in each package, can be tracked and the results made available over a network, such as the Internet") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Similarly other features and advantages upon which applicant relies (such as "a returns process of the inventions recited in claims 1 and 33, advantageously, need not employ further participation from the company that shipped the goods, as the items in each package are tracked and correlated, and a return can be processed without having to integrate with an order system of the shipper, with a customer who received and returned the goods simply filing out a form accompanying the returned goods" "Paragraphs 7 and 17 of the specification") are not recited in the rejected claim(s).

In response to applicant's argument that "By contrast, Williams et al., and Riggs et al., taken alone or in combination, neither teach, disclose nor suggest the noted features recited in independent claims 1, and 33, nor recognize or address the discovered problems with respect to conventional shipping and return systems. Accordingly, one of ordinary skill in the art would find no motivation to arrive at the invention recited in independent claims 1, and 33, based on Williams et al., and Riggs et al., absent improper hindsight reconstructions of Applicant's invention based on Applicant's disclosure", the examiner would like to point out that Riggs et al

was not used to rejected claims 1 and 33. Hence the applicant's arguments with respect to the rejection of claims 1 and 33 about motivation to combine are irrelevant and moot. As discussed in the rejection of these claims above, Williams et al. teaches all the features of the claimed invention.

Applicant's other arguments with respect to pending claims have been considered but are not persuasive and are moot in view of new grounds of rejection.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Le et al (US Pub. No. 2003/0069831 A1) (April 10, 2003) Integrated method of international trade

(b) Le et al (US Pub. No. 2003/0065949 A1) (April 3, 2003) Integrated Trade System

(c) Wells et al (US Pub. No. 2003/0065726 A1) (April 3, 2003) Combined message broker

(d) Delmer et al (US Pub. No. 2003/0065725 A1) (April 3, 2003) Verified message broker

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "N. Sub", followed by a horizontal line.

Dr. N. Subramanian

April 30, 2006